

REMARKS

Claims 81-96 are pending in this application. Support for the new claims appears throughout the specification, including the original claims.

Claims 81, 85, 89 and 93 are in independent form. Claims 81 and 85 recite methods of screening for a new crystal form of a substance, while claims 89 and 93 recite methods of screening for an amorphous form of a substance. Support for these claims appears in the specification, for example, at page 15, lines 12-19. Claims 81 and 89 recite analyzing the substance in a capillary space while the substance remains in the capillary space. Support for this aspect of the claims appears in the specification at page 12, lines 24-31. Claims 85 and 93 recite solidifying the substance in a capillary tube. Support for this aspect of the claims appears in the specification at page 15, lines 1-11. All four claims recite that the capillary space or capillary tube has an inside diameter of about 0.1 mm to about 5 mm. Support for this aspect appears in the specification at page 15, lines 1-11.

Dependent claims 82, 84, 86, 88, 90, 92, 94 and 96 recite that the capillary space or capillary tube has an inside diameter of about 0.5 mm to about 2.5 mm. Support for this aspect of the claims appears in the specification at page 15, line 7. Claims 83, 87, 91 and 95 recite analyzing the substance using transmission X-ray diffraction, and they are supported at page 18, lines 20-31 of the specification and Example 4. Lastly, claims 87 and 95 also recite that the capillary spaces form a well plate as disclosed in the specification at page 11, line 10.

Objection to the specification

The Examiner objected to the term capillary space used in the claims and specification. In support of this objection, the Examiner stated that the definition of capillary space at page 15,

lines 1-11, "completely contradicts" the conventional meaning of the term as used in, for example, the Chemistry Dictionary text cited by the Examiner.

Applicants do not agree with this objection. The dictionary definition cited by the Examiner is for the word "capillary," not for the phrase "capillary space." The present specification defines "capillary space" as a space having walls separated by from about 0.1 mm to about 30 mm. Applicants are free to define terms in the specification as long as the definitions are clear. *See* MPEP § 2173.05(a). Nonetheless, applicants have amended the claims to recite that the capillary spaces or tubes have an inside diameter from about 0.1 mm to about 5 mm. This amendment should remove the Examiner's concerns. For the Examiner's convenience, applicants also enclose a printout of an advertisement of capillary tubes having outside diameters from 0.1 mm to 5 mm, with a wall thickness of 0.01 mm. This advertisement illustrates that the size of capillary spaces now claimed does not contradict the meaning of "capillary space" or "capillary tube." In view of these remarks, applicants respectfully request that the Examiner withdraw this objection.

Objections to the claims

The Examiner objected to claim 1 for reciting "disposing the sample on one or more receptacles" and "solidifying the sample on the receptacle." The new claims do not include this text. Claims 68 and 70 were objected to for having incorrect dependency. Those claims have been canceled and the new claims recite correct dependencies. The Examiner objected to claim 80 for reciting "comprising is a well plate." The claim has been canceled. In view of the above, applicants respectfully request that the Examiner withdraw these objections.

Rejections under 35 U.S.C. § 112

The Examiner rejected claims 1-33, 35-36, 38-41 46-48, 50-65 and 67-80 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Applicants address the rejections to the extent that they may apply to the pending claims. The cancellation of the earlier claims does not mean that applicants concede the merits of any rejections.

The Examiner stated that the scope of "classifying said at least one solid form" was indefinite. None of the new claims include this text. The Examiner also questioned the meaning of "the manner wherein the analytical result is indicative of the generated solid form." None of the new claims include this text either. Several new claims recite analyzing a solid, and examples of available techniques for doing so are described, for instance, in the specification at page 18, line 20 to page 20, line 4.

The claims were rejected for reciting a "capillary space," which the Examiner stated was defined in a manner inconsistent with the conventional meaning of the term. As explained above, applicants have amended the claims to recite that the capillary spaces or tubes used in the methods have an inside diameter from about 0.1 mm to about 5 mm. This amendment should remove the Examiner's concerns.

Claim 5 was rejected for reciting "a receptacle that does not define a capillary space." The new claims do not include this phrase.

The Examiner rejected claim 12, stating that it was unclear what served as "receptacles" in a sheet with holes or pores. The pending claims do not make reference to a sheet having holes or pores, so this rejection can be withdrawn.

The Examiner rejected claim 11 as being unclear in the meaning of "capillary tube." The claim amendments reciting the dimensions of the capillary tubes should remove this rejection.

Claims 23, 28 and 31-33 were rejected for using various terms. The new claims do not include those terms so the rejections should be moot.

Claim 53 and its dependent claims 54-56 were rejected as unclear in the purpose of the claimed screens. Applicants canceled the rejected claims, and the new claims adequately recite the objectives of the screening processes.

The Examiner rejected claim 67 for reciting an "element." The term "element" does not appear in the new claims so this rejection should be moot.

Lastly, the Examiner rejected claims 77 and 80 as unclear in the distinction between a receptacle and a capillary space in a multi-well plate. The term "receptacle" does not appear in the new claims. To answer the Examiner's questions regarding these claims, a well of a multi-well plate can form a capillary space. A multi-well plate comprises two or more wells that could each serve as capillary spaces.

In view of these comments, applicants respectfully request that the Examiner withdraw the above rejections.

Rejections in view of U.S. Patent No. 6,507,636 to Lehmann

The Examiner rejected claims 1-6, 8-9, 12-14, 17, 35-36, 40, 50-52, 57-60, 62-64 and 71-70 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,507,636 to Lehmann ("Lehmann"). Applicants respectfully traverse this rejection as it may be applied to the pending claims.

Claims 81-84 and 89-92 are not anticipated and would not have been obvious because Lehmann does not teach or suggest analyzing the solid while it remains in the disclosed well plate. In fact, Lehmann deliberately separates its base plate from its masking plate before analysis, as disclosed throughout the patent. *See, e.g.*, Lehmann at col. 4, lines 20-33; col. 6, lines 25-28,

Claims 85-88 and 93-96 are not anticipated and would not have been obvious because Lehmann does not teach or suggest the use of capillary tubes. For example, the separation of the base plates and masking plates, disclosed throughout the entire patent, does not appear configured to accommodate the use of capillary tubes in place of the wells formed by the separable plates.

A number of rejections under 35 U.S.C. § 103(a) were applied to certain dependent claims pending at the time of the Office Action. Those rejections were based on a combination of Lehmann with certain secondary references. For the reasons provided above, none of the pending claims would have been obvious in view of Lehmann. The secondary references cited in the obviousness rejections would not have been combined with Lehmann to arrive at the pending claims either. Instead, those references were simply cited for teachings of features that appeared in certain dependent claims that have now been canceled.

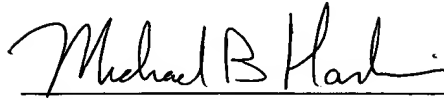
Conclusion

In view of the amendments and remarks discussed above, the pending claims should satisfy the requirements of 35 U.S.C. § 112 and should be patentable over the cited documents.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 13-0017.

Respectfully submitted,

Dated: December 23, 2003

A handwritten signature in black ink, reading "Michael B. Harlin". The signature is written in a cursive style with a horizontal line extending from the end of the name.

Michael B. Harlin

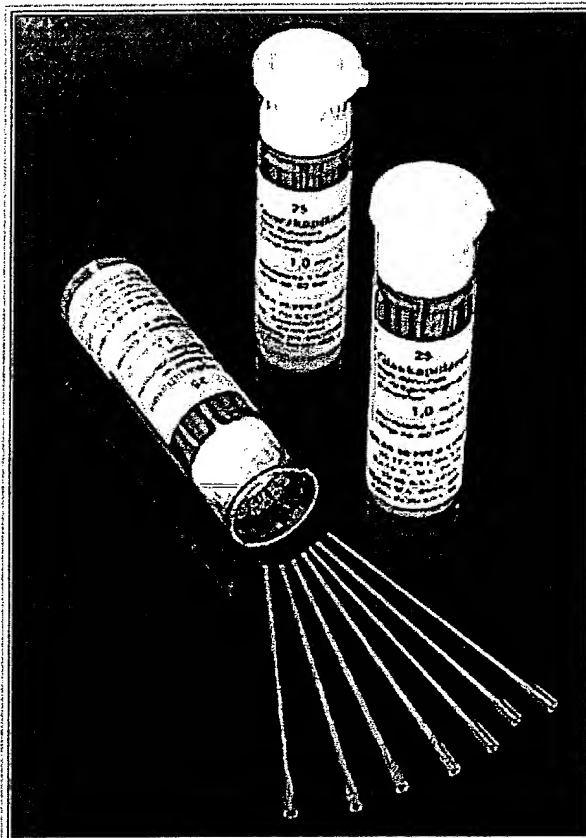
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THIN-WALLED CAPILLARY TUBES FOR X-RAY DIFFRACTION

Special Glass (SG) ~ Boron-Rich (BG) ~ Quartz (QZ)



- Manufactured to the highest standards by Wolfgang Muller Glas Technik.
- Standard Glas Technik Features:
- Wall Thickness - 0.01mm Overall Length - 80mm

Drawn from clear, fresh and properly cleaned glass;
 Funnel at one end, sealed at the other;
 Supplied in non-confusing, color coded glass packages containing 25 tubes;
 Individual tubes are easily removed from glass package without fumbling and searching through the container.

- Exclusively distributed in North America since 1972 by the Charles Supper Co.
- **Over 50 sizes** are available from our inventory **for immediate shipment.**
- Special tubes will be quoted upon your request and specification.

Special Glass (SG)
Blue Label

Boron Rich (BG)
Green Label

Quartz (QZ)
Red Label

Cat #	O.D.	Price Per Pkg	Cat #	O.D.	Price Per Pkg	Cat #	O.D.	Price Per Pkg
01-SG	0.1mm	\$41.00	01-BG	0.1mm	\$56.00	01-QZ	0.1mm	\$71.00
02-SG	0.2mm	\$34.00	02-BG	0.2mm	\$47.00	02-QZ	0.2mm	\$70.00
03-SG	0.3mm	\$30.00	03-BG	0.3mm	\$40.00	03-QZ	0.3mm	\$69.00
04-SG	0.4mm	\$35.00	04-BG	0.4mm	\$47.00	04-QZ	0.4mm	\$80.00
05-SG	0.5mm	\$30.00	05-BG	0.5mm	\$40.00	05-QZ	0.5mm	\$69.00
06-SG	0.6mm	\$35.00	06-BG	0.6mm	\$48.00	06-QZ	0.6mm	\$80.00
07-SG	0.7mm	\$30.00	07-BG	0.7mm	\$40.00	07-QZ	0.7mm	\$69.00
08-SG	0.8mm	\$38.00	08-BG	0.8mm	\$48.00	08-QZ	0.8mm	\$84.00

09-SG	0.9mm	\$38.00	09-BG	0.9mm	\$50.00	09-QZ	0.9mm	\$84.00
10-SG	1.0mm	\$33.00	10-BG	1.0mm	\$46.00	10-QZ	1.0mm	\$69.00
15-SG	1.5mm	\$38.00	15-BG	1.5mm	\$54.00	15-QZ	1.5mm	\$75.00
20-SG	2.0mm	\$56.00	20-BG	2.0mm	\$77.00	20-QZ	2.0mm	\$87.00
25-SG	2.5mm	\$58.00*	25-BG	2.5mm	\$72.00*	25-QZ	2.5mm	\$89.00*
30-SG	3.0mm	\$64.00*	30-BG	3.0mm	\$92.00*	30-QZ	3.0mm	\$123.00*
35-SG	3.5mm	\$60.00**	35-BG	3.5mm	\$80.00**	35-QZ	3.5mm	\$119.00**
40-SG	4.0mm	\$43.00***	40-BG	4.0mm	\$69.00***	40-QZ	4.0mm	\$83.00***
50-SG	5.0mm	\$76.00***	50-BG	5.0mm	\$113.00***	50-QZ	5.0mm	\$139.00***

25 Tubes per package (unless otherwise noted by asterisk(s))

* package of 15 All prices f.o.b. Natick, Massachusetts
 ** package of 10 USA
 *** package of 5 Terms: Net 30 or Credit Card

All Tubes: 80mm long 0.01 wall thickness

All sizes available from Stock

Please note due to currency fluctuations, prices may change without notice.

We do accept Master Card and VISA.